

05-15-06 06:48pm From-PILLSBURY WINTHROP SHAW PITTMAN LLP +858-509-4010 T-656 P.015/022 F-453
REESE ET AL. - 10/656,002
Attorney Docket: 044182-0305880

IN THE DRAWINGS:

The attached sheets of drawings include changes to FIGs. 1 and 4 now FIGS 1A and 1B and FIGs. 4A-4C respectively. Replacement sheets for the original sheets showing FIGs 1 and 4 are provided.

The attached sheets of drawings additionally include changes to FIG. 2. A replacement sheet for the original sheets showing FIG 2 is provided.

The attached sheets of drawings additionally include newly added drawing FIG 5.

Attachment: Replacement Sheets.

REMARKS

In the Office Action the drawings are objected to due to informality issues and under 37 C.F.R. 1.83(a) for not showing every feature of the invention specified in the claims. Corrected drawing sheets are required. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 1, 2, 4-7, 9, 12-15, 17, 19 and 20 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,262,991 to Wagener et al. ("Wagener"). Claims 8, 16 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wagener in view of U.S. Patent 5,900,708 to Den Engelse et al. ("Den Engelse").

The Drawings

Applicants have amended the drawings as requested in the Office Action. The sheets including FIGS. 1 and 4 have been amended to reflect individual Figure numbering of the parts. FIG. 2 has been amended to show an embodiment including motors as described in the Specification. In addition, FIG. 5 is added. FIG. 5 is fully supported in the Specification, adds no new matter and more clearly sets forth certain aspects of the claimed inventions. Applicants respectfully request withdrawal of the objections to the drawings.

The §112 Rejections

In the Office Action, claim 3 stands rejected as failing to comply with the enablement requirement. Applicants respectfully submit that the Specification provides adequate description of translation of the substrate holder in two dimensions relative to the fixed portion. For example:

As is apparent from examination of FIG. 2, guide pins 118 or other suitable structures may constrain movable portion 120 such that motion along one axis may be restricted. Alternatively, some embodiments may accommodate two dimensional travel for movable portion 120 relative to fixed portion 110, such as through implementation of one or more additional gear mechanisms and suitable tracks, rails, guides, and interoperable structures such as are generally known in the art.

(Specification at page 9, lines 18-24). Nevertheless, Applicants have amended the Drawings to include newly added Fig. 5 that illustrates, *inter alia*, accommodation of two dimensional travel for movable portion 120 relative to fixed portion 110, such as through implementation of one or more additional gear mechanisms and suitable tracks, rails, guides, and interoperable structures such as are generally known in the art. Applicants have amended the

specification to include reference to Fig. 5 and submit that the amendments add no new matter and are entirely consistent with the written description as originally provided.

Therefore, for at least these reasons the §112 rejection of claim 3 should be withdrawn.

The §102 Rejections

The Office Action alleges that Wagener anticipates each and every element of claims 1-2, 4-7, 9, 12-15, 12 and 19-20. Applicants respectfully disagree. Wagener relates to a travel stage for microscopes teaching "a stage plate which is displaceable in one coordinate direction with respect to a fixed plate and an object guide displaceable in the stage plate in a second direction" (col. 1, lines 1-8). Additionally, Wagener obliquely refers to an object holder that is clamped to an object guide located in a recess of the microscope stage plate (col. 1, line 68 – col. 2, line 6). In its Abstract, Wagener refers to a base plate along which a stage plate is displaceable in one coordinate direction, and an object plate displaceable along the stage plate in a second coordinate direction (Abstract). This combination of components does not anticipate the presently claimed invention.

Wagener does not teach *inter alia* a fixed portion coupled to a precision stage, a movable portion coupled to said fixed portion and selectively movable relative thereto and a securing mechanism configured and operative to secure a substrate at a predetermined location relative to said movable portion, as required in the claims. In the Office Action, the rejection is based on an assertion that the Wagener microscope stage anticipates both the required precision stage and the required movable portion. Applicants respectfully submit that the microscope stage cannot reasonably be said to anticipate these two distinct claim elements.

Furthermore, Wagener merely teaches a "fixed part" attached to a microscope and a microscope stage plate that is movable with respect to the fixed part (col. 1, line 67 – col. 2, line 10). Wagener's object holder/plate is also translatable with respect to the microscope stage. Even adopting *arguendo* the characterization of Wagener in the Office Action Wagener could only be said to teach a movable portion coupled to a *movable microscope stage* which microscope stage is coupled to a fixed base plate. Since this structure differs from that claimed, Wagener cannot be reasonably said to teach all elements of the claims.

Applicants also observe that Wagener does not teach the require substrate or securing the substrate a predetermined location with respect to the movable portion. Wagener is

clearly incapable of resolving the issues addressed by the present invention and, in particular, could not overcome the constraints associated with utilizing a limited travel precision stage to view a substrate that potentially occupies a larger area than the precision stage's range of travel. Wagener does not teach operatively attaching a microscope stage to a second stage. Even if Wagener's microscope stage were attached to another stage, Wagener still would not teach the actual substrate or object holder.

For at least these reasons, the rejections of claims under §102 should be withdrawn.

The §103 Rejections

Regarding claims 8, 16 and 18, Den Engelse does not cure the deficiencies of Wagener. Consequently, claims 8, 16 and 18 are allowable for at least the reason that the base claims from which they depend are allowable.

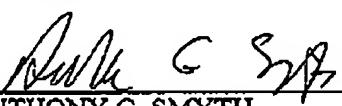
The Allowable Subject Matter

Applicants thank the Examiner for acknowledging the allowable subject matter in claims 10 and 11. Applicants believe that the base claims from which claims 10 and 11 depend are also allowable and therefore opt not to amend the claims at this time.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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